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APPLICATION NO)	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,978 10/06/2000		Jing Min	5796-01-MJA	7511	
28523	7590	11/12/2003		EXAMINER	
PFIZER I		AFNIT NG0260 1611	CARLSON, KAREN C		
EASTERN		MENT, MS8260-1611 ROAD	ART UNIT	PAPER NUMBER	
GROTON,	CT 063	340	1653		
			DATE MAILED: 11/12/2003		

Please find below and/or attached an Office communication concerning this application or proceeding.

• ' .								
		Appli	cation No.	Applicant(s)				
	Office Andieus Communication	09/64	7,978	MIN ET AL.				
Office Action Summary			in r	Art Unit				
			Cochrane Carlson, Ph.D.	1653				
Period fe	The MAILING DATE of this commo or Reply	unication appears or	the cover sheet with the	correspond nce ac	Idress			
THE - Exte after - If the - If NO - Failt - Any	ORTENED STATUTORY PERIOD MAILING DATE OF THIS COMMUI insions of time may be available under the provision SIX (6) MONTHS from the mailing date of this core period for reply specified above is less than thirty or period for reply is specified above, the maximum ure to reply within the set or extended period for represerved by the Office later than three monthed patent term adjustment. See 37 CFR 1.704(b).	NICATION. ons of 37 CFR 1.136(a). In remunication. (30) days, a reply within the statutory period will apply a ply will, by statute, cause this after the mailing date of the	no event, however, may a reply be to e statutory minimum of thirty (30) da nd will expire SIX (6) MONTHS from e application to become ABANDONI	mely filed ys will be considered timel n the mailing date of this c ED (35 U.S.C. § 133).	ly. communication.			
1)🖂	Responsive to communication(s) f	iled on <u>25 July 200</u>	<u>3</u> .					
2a)□	This action is FINAL .	2b)⊠ This action i	s non-final.					
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposit	ion of Claims							
5)□ 6)⊠ 7)□	Claim(s) 1-26 is/are pending in the 4a) Of the above claim(s) 1-11 and Claim(s) is/are allowed. Claim(s) 12 and 21-26 is/are reject Claim(s) is/are objected to. Claim(s) are subject to restrict.	<u>/ 13-20</u> is/are withdo						
	ion Papers	indian diraya, aradi.	in rodan omone.					
9)[The specification is objected to by	the Examiner.						
10)	The drawing(s) filed on is/ar	e: a) accepted o	r b) objected to by the	Examiner.				
	Applicant may not request that any ob	jection to the drawing	(s) be held in abeyance. Se	e 37 CFR 1.85(a).				
	Replacement drawing sheet(s) including	ng the correction is re	quired if the drawing(s) is ob	ojected to. See 37 Cl	FR 1.121(d).			
11)	The oath or declaration is objected	to by the Examiner	. Note the attached Office	Action or form P7	ΓΟ-152.			
Priority (under 35 U.S.C. §§ 119 and 120							
a) 13)⊠ A s 3 14)□ A	Acknowledgment is made of a clai All b) Some * c) None of Certified copies of the priorit Certified copies of the priorit Copies of the certified copie application from the Internat See the attached detailed Office act Acknowledgment is made of a claim ince a specific reference was included. TCFR 1.78. The translation of the foreign lacknowledgment is made of a claim eference was included in the first see	ty documents have by documents have so of the priority document have sof the priority document (PCT ion for a list of the confort domestic priority anguage provisional for domestic priority for domestic priority	been received. been received in Applicat uments have been receiv Rule 17.2(a)). certified copies not receive y under 35 U.S.C. § 119(nce of the specification o I application has been rec y under 35 U.S.C. §§ 120	tion No ed in this National ed. (e) (to a provisional or in an Application ceived. of and/or 121 since	Il application) Data Sheet. a specific			
Attachmen	it(s)							
2) Notic	ce of References Cited (PTO-892) ce of Draftsperson's Patent Drawing Review mation Disclosure Statement(s) (PTO-1449)			/ (PTO-413) Paper No(Patent Application (PTC				

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Applicant's election with traverse of Invention V, Claims 12 and new Claims 21-26, in the paper filed July 25, 2003 is acknowledged. The traversal is on the ground(s) that Claim 13 should be examined with Invention V, Claim 12 and 21-26 because Claim 13 is drawn to determining ligand for SNYIP and Claim 12 is drawn to determining compounds which interfere with the interaction of SYNIP and a determined ligand. This is not found persuasive because these methods are different in concept and in compound and therefore these two inventions are patentably distinct for reasons of record.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-26 are currently pending. Claim 1-11 and 13-20 have been withdrawn from further consideration by the Examiner because these claims are drawn to non-elected inventions. Claims 12 and 21-26 are currently under examination.

Priority is set to April 19, 1998.

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear in Claim 12 what is meant by "SYNIP". At page 2 of the specification, "SYNIP" is specifically defined as the acronym for syntaxin-4 interacting protein. Yet at page 12, para. 1, of the specification, "SYNIP" is broadly defined as not only being naturally occurring SYNIPs (syntaxin-4 interacting protein) but also functional derivatives and variants of SYNIPs. A

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"functional derivative" is defined as any compound having a qualitative biological activity in common with a native SYNIP, such as the ability to bind to syntaxin-4 or other cognate ligands. What other "cognate ligands" are included in this definition? Indeed, at the last sentence of page 12, para. 1, the functional derivative can include peptides and small organic molecules having qualitative biological activity. "Derivative" (an variants) is further defined as amino acid and glycosylation variants, as well as covalent modifications of SYNIP. Therefore, the functional derivatives and variants that are included in the definition of "SYNIP" need not have a common structure with SYNIP, or even bind to syntaxin-4. The definition of "SYNIP" at page 12 is so broad as to be meaningless because there is no definite structure and no definite function set forth.

Claim 12 is not clear because the term "syntaxin-4" is defined as including but not limited to syntaxin-4 and the like. What is "and the like"?

It is not clear in Claim 12 what is meant by the phrase "interferes with the interaction". At page 6, para. 3, of the specification, the term "interaction" is stated to include but is not limited to binding, affecting, and regulating. Thus, it is not clear how a compound interferes with the affect of SYNIP and syntaxin-4, or interferes with the regulation of SYNIP and syntaxin-4.

In each of Claims 21, 23, and 24, it is not clear what a polypeptide would look like if it had an amino acid "substantially similar" to SEQ ID NO: 2 or SEQ ID NO: 5.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12 and 21-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably

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convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification fails to describe SYNIPs as defined on page 12, para. 1. Specifically, the specification defines "SYNIP" broadly as not only being naturally occurring SYNIPs (syntaxin-4 interacting protein) but also functional derivatives and variants of SYNIPs. A "functional derivative" is defined as any compound, peptides, or small organic molecules having a qualitative biological activity in common with a native SYNIP, such as the ability to bind to syntaxin-4 or other cognate ligands. The specification does not describe any compound, peptides, or small organic molecules having a qualitative biological activity in common with a native SYNIP (syntaxin-4 interacting protein) and having the ability to bind to syntaxin-4. The specification does not describe any other "cognate ligands" that bind to SYNIP (syntaxin-4 interacting protein). The specification does not describe any "derivative" (an variants) that are amino acid and glycosylation variants of SYNIP, as well as covalent modifications of SYNIP. Therefore, The specification does not describe functional derivatives and variants that that are included in the definition of "SYNIP", which need not have a common structure with SYNIP, or even bind to syntaxin-4.

The specification does not describe syntaxin-4 like compounds, wherein syntaxin-4 is defined as being syntaxin-4 "and the like".

The specification doe not describe any compound that "interferes with the interaction" of SYNIP and syntaxin-4, or how this interference would be assessed. At page 6, para. 3, of the specification, the term "interaction" is stated to include but is not limited to binding, affecting, and regulating. Thus, the specification does not teach how to assay for a compound that interferes with the affect of SYNIP and syntaxin-4, or interferes with the regulation of SYNIP and syntaxin-4.

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The specification does not teach polypeptide that are "substantially similar" to SEQ ID NO: 2 or SEQ ID NO: 5 and having function.

Thus, the specification lacks written description of the invention as claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 703-308-0034. Upon the move of the PTO to Alexandria, VA in January, 2003, the telephone number will be 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low can be reached on 703-308-2329. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER

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